

**DOCKET NO.:** UPNA-0034/P2925  
**Application No.:** 10/526,941  
**Office Action Dated:** October 14, 2008

**PATENT**

**Amendments to the Drawings**

The attached sheets of drawings includes changes to Figs 1-2, 7-9, and 11-12. The sheets include replacement drawings for Figures 1-2, 7-9, and 11-12. There have not been any changes made to the original drawings.

Attachment: 7 Replacement Sheets

### **REMARKS**

Claims 1-139 are pending in this application. No new matter is being entered upon entry of these amendments.

Claims 11, 16-17, 22-28, 44, 47-49, 57, 93-99, and 105 have been amended to correct punctuation errors. Claims 35 and 36 have been amended and find support in the original claims as filed, as well as in the specification at least at [0019] and [0020]. Claims 49 and 93-97 have been amended and find support in the original claims as filed, as well as in the specification at least at [0061].

Drawings were objected to as being of insufficient quality. Applicants have provided clearer drawings.

### **Claim Objections**

Claims 11, 22-28, 44, 47-49, 57, 93-99, and 105 were objected to because of various informalities. Although Applicant does not necessarily agree, these claims have been amended in order to advance prosecution.

### **Rejections Under 35 USC § 112**

Claims 16-17, 22-26, 28, 35-36, 49, 51-52, and 93-97 stand rejected under 35 USC § 112 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Although Applicants do not necessarily agree, these claims have been amended to make them even cleared.

Applicant traverses the examiner's rejection of claims 51-52. According to MPEP 2173.05(e), inherent components of elements recited have antecedent basis in the recitation of the components themselves. In this regard, the compositions recited in the independent claims inherently have some surfactant concentration. Likewise, the carbon nanotubes recited in the independent claims inherently have electronic, thermal, and mechanical properties. Therefore, Applicant's claims 51 and 52 are not indefinite for lacking antecedent basis. (See MPEP 2173.05(e) and Bose Corp. v. JBL, Inc., 274 F.3d 1354, 1359, 61 USPQ2d 1216, 1218-19 (Fed. Cir. 2001) (holding that recitation of "an ellipse" provided antecedent basis for "an ellipse having a major diameter" because "[t]here can be no dispute that

mathematically an inherent characteristic of an ellipse is a major diameter.”)). Applicants request that the rejections of claims 51 and 52 be withdrawn.

### **Rejections Under 35 USC § 102**

Claims 1-13, 15-18, 55-60, and 139 stand rejected under 35 USC § 102(e) as allegedly being anticipated by Smalley et al. (US 2003/0133865 A1) (“Smalley”). Applicants traverse this rejection.

Smalley teaches against the use of surfactants such as NaDDBS, stating that the use of this surfactant yields low concentrations of singlewall carbon nanotubes. (*Id.* at col. 3, lines 28-35). Instead, Smalley teaches dispersions of singlewall carbon nanotubes in 100% sulfuric acid or another superacid. (Smalley, col. 4, lines 36-43 and 64-67). Based on this disclosure, a person of ordinary skill in the art would not anticipate that using a surfactant, such as NaDDBS, would result in the high concentration carbon nanotube dispersions. For at least these reasons, Applicant’s claims are not anticipated by Smalley. Applicants request that the rejections of claims 1-13, 15-18, 55-60, and 139 be withdrawn. Moreover, the rejections of claims 3, 9, and 56, alleging inherency, should also be withdrawn

### **Rejections Under 35 USC § 103**

Claims 19-36 and 98-99 stand rejected under USC § 103(a) as allegedly being unpatentable over Smalley, as applied to claim 1 as stated above. For at least the same reasons stated above with respect to claim 1, Applicant traverses the rejections, as Smalley does not disclose or suggest the claimed invention.

Claims 14 and 31-34 stand rejected under USC § 103(a) as allegedly being unpatentable over Smalley as applied to claim 1 as stated above, and further in view of Wei et al. (US 6,899,947 B2). For at least the same reasons stated above with respect to claim 1, Applicant traverses the rejections, as Smalley does not disclose or suggest the claimed invention. Therefore, the rejection in view of Wei is moot.

Claims 37-52 stand rejected under USC § 103(a) as allegedly being unpatentable over Lobovsky et al. (US 2002/0113335 A1) in view of Smalley. For at least the same reasons stated above, Applicant traverses the rejections, as Smalley does not disclose or suggest the claimed invention. Therefore, the rejection over Lobovsky is moot.

Claims 53-54 stand rejected under USC § 103(a) as allegedly being unpatentable over Lobovsky in view of Smalley as applied to claim 37 above, and further in view of Yamamoto et al. (*Journal of Physics D*). For at least the same reason stated above, with respect to claim 37, Applicant traverses the rejections. Therefore, the rejection in view of Yamamoto is moot.

Claims 61-63, 69-70, 72, 74-101, 103-109, and 124-126 stand rejected under USC § 103(a) as allegedly being unpatentable over Glatkowski (US 2003/0122111 A1) in view of Smalley. For at least the same reasons stated above, Applicant traverses the rejections, as Smalley does not disclose or suggest the claimed invention. Therefore, the rejection over Glatkowski is moot.

Claims 64-68 stand rejected under USC § 103(a) as allegedly being unpatentable over Glatkowski in view of Smalley and Wei. For at least the same reasons stated above with respect to Glatkowski, Smalley, and Wei, Applicant traverses the rejections.

Claims 71 and 102 stand rejected under USC § 103(a) as allegedly being unpatentable over Glatkowski in view of Smalley as applied to claims 69 and 74 above, and in further view of Wei. For at least the same reasons stated above with respect to claims 69 and 74, Applicant traverses the rejections.

Claim 73 stands rejected under USC § 103(a) as allegedly being unpatentable over Glatkowski in view of Smalley as applied to claim 69 above, and further in view of Cho et al. (US 7, 013, 708 B1). For at least the same reasons stated above with respect to claim 69, Applicant traverses the rejection. Therefore, the rejection in view of Cho is moot.

Claims 110-111 stand rejected under USC § 103(a) as allegedly being unpatentable over Glatkowski in view of Smalley as applied to claim 105 above, and in further view of Pienkowski et al. (US 2002/0001620 A1). For at least the same reasons stated above with respect to claim 105, Applicant traverses the rejections. Therefore, the rejection over in view of Pienkowski is moot.

Claims 112-122 stand rejected under USC § 103(a) as allegedly being unpatentable over Glatkowski in view of Smalley as applied to claim 75 above, and further in view of Ilmain (*Nature*). For at least the same reasons stated above with respect to claim 75, Applicant traverses the rejections. Therefore, the rejection in view of Ilmain is moot.

Claim 123 stands rejected under USC § 103(a) as being unpatentable over Glatkowski in view of Smalley as applied to claim 74 above, and further in view of de Heer et al. (*Science*). For at least the same reasons stated above with respect to claim 74, Applicant traverses the rejection. Therefore, the rejection in view of Heer is moot.

Claims 127-133 stand rejected under USC § 103(a) as being unpatentable over Glatkowski in view of Smalley as applied to claim 126 above, and further in view of Shambaugh (US 7,001, 556 B1). For at least the same reasons stated above with respect to claim 126, Applicant traverses the rejections. Therefore, the rejection in view of Shambaugh is moot.

Claims 134-136 stand rejected under USC § 103(a) as being unpatentable over Glatkowski in view of Smalley as applied to claim 75 above, and further in view of Smith et al. (*Applied Physics Letters*). For at least the same reasons stated above with respect to claim 75, Applicant traverses the rejections. Therefore, the rejection in view of Smith is moot.

Claims 137-138 stand rejected under USC § 103(a) as allegedly being unpatentable over Glatkowski in view of Smalley as applied to claim 74 above, and further in view of Barrera et al. (WO 01/92381 A1). For at least the same reasons stated above with respect to claim 74, Applicant traverses the rejections. Therefore, the rejection in view of Barrera is moot.

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**Conclusion**

Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record, and that the current application is in condition for allowance. An indication of allowability of all pending claims is respectfully requested.

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